



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/290,363 04/12/99 PEINADO

M MSFT-0035

TM02/0424

WOODCOCK WASHBURN KURTZ MACKIEWICZ
AND NORRIS
ONE LIBERTY PLACE
46TH FLOOR
PHILADELPHIA PA 19103

EXAMINER

NGUYEN, C

ART UNIT	PAPER NUMBER
----------	--------------

2165

DATE MAILED:

04/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 09/290,363	Applicant(s) Pelnado et al.
Examiner Cuong H. Nguyen	Group Art Unit 2165

Responsive to communication(s) filed on Oct 25, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 1-105 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
 Claim(s) _____ is/are allowed.
 Claim(s) 1-105 is/are rejected.
 Claim(s) _____ is/are objected to.
 Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
 The drawing(s) filed on _____ is/are objected to by the Examiner.
 The proposed drawing correction, filed on _____ is approved disapproved.
 The specification is objected to by the Examiner.
 The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 All Some* None of the CERTIFIED copies of the priority documents have been received.
 received in Application No. (Series Code/Serial Number) _____
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892
 Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
 Interview Summary, PTO-413
 Notice of Draftsperson's Patent Drawing Review, PTO-948
 Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

S.N.: 09/290,363

Art Unit: 2165

1. This Office Action is the answer to the IDS received on 10/25/1999, which paper has been placed of record.
2. Claims 1-105 are pending in this application.

Drawings

3. This application has been filed with informal drawings, and they are required to be corrected as indications by the draftsman.
4. The following rejections are based on the examiner's broadest reasonable interpretation of the claims; *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Claim Rejections - 35 USC § 112

5. Claims 1-29, 56-105 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Further, the scope of a "means" limitation is defined as the corresponding structure or material (e.g., a specific logic circuit) set forth in the written description and equivalents. See MPEP § 2181 through § 2186. Thus, a claim using means plus function limitations (i.e. claims 1-29, 56-82, 83-105), of this application) without corresponding disclosure of specific structures or materials that are not well-known fails to

09/290,530
Art Unit 2165

particularly point out and distinctly claim the invention.

Dossel, 115 F.3d at 946-47, 42 USPQ2d at 1884-85. For example, if the applicants disclose only the functions to be performed and provides no express disclosure of hardware or a combination of hardware and software that performs the functions, the application has not disclosed any "structure" which corresponds to the claimed means. Office personnel should reject such claims under 35 U.S.C. 112, 2nd para. (E.g., in independent claim 1, the functions for following actions: for distributing, for issuing, for receiving, for rendering, for being invoked, for determining, .etc., in independent claim 56, the functions for following actions: for distributing, for issuing, for receiving, for storing, for attempting to render, for being invoked by the rendering application, for determining whether a right to render...etc., in independent claim 83, the functions for following actions: authoring the digital content, for receiving the digital content from the authoring tool and distributing the digital content; for issuing at least one digital license, receiving, storing, for being invoked by the rendering application, for determining whether a right to render the digital content .etc.

Claim Rejections - 35 USC § 103

09/290,530
Art Unit 2165

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Since claims **56-82** of the application obviously suggests all limitations of claims **1-55, 83-105**, claims 56-82 are examined herein, other claims would have been rejected based on similar rationale and references (instead of restriction of those claims) because those claims would have a lesser/broader limitations, or being very obvious in view of the given references and analysis for claims 56-82.

7. Claims **56-82** are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik (US Pat. 5,715,403), in view of Rabne et al., (US Pat. 6,006,332) about a rights management system for digital media, and further in view of Shear et al., (US Pat. 6,112,181 about systems and methods for matching, selecting, narrowcasting, and classifying based on rights management), and further in view of the Official Notice.

A. Re. to claim 56: Claim 56 is directed to a structure/system/architecture for digital rights management, wherein the structure

09/290,530
Art Unit 2165

/system/architecture protect digital contents, the structure/system/architecture, Stefik ('403) obviously suggests this concept in his patent about "System for controlling the distribution and use of digital works having attached usage rights"; comprising:

- a content server for distributing the content over a network (this feature is inherent in Stefik's patent);
- a license server for issuing a license over said network (see Stefik ('403): "A system for ensuring that licenses are in place for using licensed products is described in PCT Publication WO 93/01550 to Griswold entitled "License Management System and Method." The licensed product may be any electronically published work but is most effective for use with works that are used for extended periods of time such as software programs. Griswold requires that the licensed product contain software to invoke a license check monitor at predetermined time intervals. The license check monitor generates request datagrams which identify the licensee. The request datagrams are sent to a license control system over an appropriate communication facility. The license control system then checks the datagram to determine if the datagram is from a valid licensee. The license control system then sends a reply datagram to the license check monitor indicating denial or approval of usage. The license control

09/290,530
Art Unit 2165

system will deny usage in the event that request datagrams go unanswered after a predetermined period of time (which may indicate an unauthorized attempt to use the licensed product). In this system, usage is managed at a central location by the response datagrams. So for example if license fees have not been paid, access to the licensed product is terminated.");

- - a computer to receive contents and a corresponding license; said computer has a memory, a use of said content, and being invoked by a use of said content (see Stefik ('403)).

However, the examiner also submits that all claimed's limitations are well-known in the art (see extra cited references, and submitted IDS); cited prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior references are also directed to a similar system/method for digital rights management. Cited prior arts are not limited to the described embodiments in these disclosures. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these inventions have been described in connection with specific preferred embodiments, it should be understood that the invention

09/290,530
Art Unit 2165

as claimed should not be unduly limited to such specific embodiments.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to suggest a system for combining the available teaching references (submitting as IDS documents) in the disclosure of Stefik, because this would implement extra features of Stefik operation of a digital right management system.

B. Re. to claim 57: Claim 57 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stefik, in view of the Official Notice.

Stefik suggests all of the elements claimed with the exception of using information over the Internet as the method of paying for the purchased books. The examiner takes Official Notice that paying for purchases using credit card information sent over the Internet is old and well established in the business of e-commerce as a convenient way for a consumer to pay for purchased items. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of paying for the book purchases in Smith by using credit card information sent over the Internet because the skilled artisan would have recognized that this business practice streamlines the process and saves time spent by a consumer in

09/290,530
Art Unit 2165

making purchases and is clearly applicable to the sale of any type of product. These advantages are well known to those skilled in the art.

C. Re. to claim 57: The rationale for rejection of claim 56 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art for: a server is coupled to the Internet and distributing data/(digital content) over the Internet (see at least the submitted articles in IDS of **Hauser**, R.C.; **Kaplan**, M.A.; **Kohl**, U. et al.; **Silbert**, O. et al.; **Stefik**, M.; **Weber**, R.; and **Ramanujapuram**, A. et al.).

D. Re. to claim 58: The rationale for rejection of claim 56 are incorporated. The examiner submits that the content of this claims are very well-known in computer-related art for: a license server is coupled to the Internet and issues license over the Internet (see at least the submitted articles of **Hauser**, R.C.; **Kaplan**, M.A.; **Kohl**, U. et al.; **Silbert**, O. et al.; **Stefik**, M.; **Weber**, R.; and **Ramanujapuram**, A. et al.).

E. Re. to claim 59: The rationale for rejection of claim 56 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art for: a server is coupled to a portable medium writer and distributing content on a portable medium written by the portable medium

09/290,530
Art Unit 2165

writer, the portable medium selected from an optical storage medium (e.g. a CD), and a magnetic storage medium (e.g. a 3.5" floppy diskette), and wherein the computing device includes a portable medium reader corresponding to the portable medium writer for receiving and reading the portable medium.

F. Re. to claim 60: The rationale for rejection of claim 56 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art for: a server distributes contents in an encrypted form.

G. Re. to claim 61: The rationale for rejection of claim 60 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art for: a digital object/license having:

- a decryption key that decrypts the encrypted digital content; and
- a description of the rights conferred by the license, wherein the encrypted digital content cannot be decrypted and rendered without obtaining such license from the license server.
(see at least the submitted articles of the IDS).

H. Re. to claim 62: The rationale for rejection of claim 61 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art for: a digital object/license including a digital signature (that binds

09/290,530
Art Unit 2165

the license to the encrypted digital content - this is too obvious) (see at least the submitted articles of the IDS).

I. Re. to claim 63: The rationale for rejection of claim 56 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art for: structure/system/architecture wherein if the DRM system determines that the right to render the digital content in the manner sought does not exist based on any digital license stored in the computing device and corresponding to the digital content, such DRM system directs a computing device user to the license server to obtain a digital license to render such digital content in the manner sought (see at least the submitted articles of the IDS).

J. Re. to claim 64: The rationale for rejection of claim 56 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art for: a structure/system/architecture, wherein if the DRM system determines that the right to render the digital content in the manner sought does not exist based on any digital license stored in the computing device and corresponding to the digital content, such DRM system transparently obtains a digital license from the license server without any action necessary on the part of a

09/290,530
Art Unit 2165

computing device user (see at least the submitted articles of the IDS).

K. Re. to claim 65: The rationale for rejection of claim 56 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art for: a structure/system/architecture, wherein the DRM system includes a license store for storing digital licenses (see at least the submitted articles of the IDS).

L. Re. to claim 66: The rationale for rejection of claim 56 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art for: a structure/system/architecture, wherein each digital license corresponding to the digital content is bound to such digital content (see at least the submitted articles of the IDS).

M. Re. to claim 67: The rationale for rejection of claim 66 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art for: a structure/system/architecture, wherein each digital license corresponding to the digital content is bound to such digital content by way of a public/private key technique. (see at least the submitted articles of the IDS).

N. Re. to claim 68: The rationale for rejection of claim 56 are incorporated. The examiner submits that the content of this

09/290,530
Art Unit 2165

claims are notoriously well-known in computer-related art: a structure/system/architecture, wherein the license server issues a digital license to a DRM system only if the license server trusts such DRM system to abide by the license (see at least the submitted articles of the IDS).

O. Re. to claim 69: The rationale for rejection of claim 68 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture, wherein the content server distributes the digital content in an encrypted form, and wherein the DRM system includes a trusted black box for performing decryption and encryption functions for such DRM system.

P. Re. to claim 70: The rationale for rejection of claim 69 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture, wherein the black box includes a unique public/private key pair (for performing the decryption and encryption functions); the fact that a black box includes a public/private key pair is not an inventive concept because of such an extra inclusion.

O. Re. to claim 71: The rationale for rejection of claim 70 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a

09/290,530
Art Unit 2165

structure/system/architecture, wherein the license server issues each digital license in response to a license request from the DRM system, the license request including the black box public key, the license server encrypting at least a portion of the digital license according to the black box public key prior to issuance of such license, thereby binding such license to such black box (see at least the submitted articles of the IDS).

R. Re. to claim 72: (Object due to a rejected parent claim) The rationale for rejection of claim 69 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture, wherein the server distributes the content in an encrypted form, wherein each license corresponding to the content includes a decryption key, and wherein the license server encrypts the decryption key in the license according to the black box public key.

S. Re. to claim 73: The rationale for rejection of claim 72 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture, wherein each digital license corresponding to the digital content further includes a description of the rights conferred by the license, wherein the encrypted digital contend cannot be decrypted and rendered

09/290,530
Art Unit 2165

without obtaining such license from the license server, and
wherein the license server encrypts the rights description in the
license according to the decryption key.

T. Re. to claim 74: The rationale for rejection of claim 69 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture, wherein the black box includes a version number.

U. Re. to claim 75: The rationale for rejection of claim 69 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture, wherein the license server issues each digital license in response to a license request from the DRM system, the license request including the version number of the black box, the license server determine prior to issuance of the license whether the version number of the black box is acceptable, the license server upon determining that the version number of the black box is not acceptable refusing to issue the license until the black box is updated, the structure/system/architecture further comprising a black box server for providing an updated black box to the DRM system.

V. Re. to claim 76: The rationale for rejection of claim 69 are incorporated. The examiner submits that the content of this

09/290,530
Art Unit 2165

claims are notoriously well-known in computer-related art: a structure/system/architecture, wherein the black box includes a certifying authority signature (as provided by an approved certifying authority); the fact that a black box includes a certifying authority signature is not an inventive concept because of a task that putting a signature at a place.

W. Re. to claim 77: The rationale for rejection of claim 76 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture, wherein the license server issues each digital license in response to a license in response to a license request from the DRM system, the license request including the certifying authority signature, the license server determining prior to issuance of the license whether the certifying authority signature is valid.

X. Re. to claim 78: The rationale for rejection of claim 68 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture, wherein each digital license corresponding to the digital content includes a description of the rights conferred by the license, and wherein the DRM system includes a trusted license evaluator for evaluating the rights description and allowing rendering of the digital contend by the

09/290,530
Art Unit 2165

rendering application only if such rendering is in accordance with the rights description of the license.

Y. Re. to claim 79: The rationale for rejection of claim 56 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture comprising an issued license database for maintaining information on digital licenses issued by the license server, wherein if the computing device loses a received license, a re-issue thereof may be provided based on the information in the issued license database.

Z. Re. to claim 80: The rationale for rejection of claim 56 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture comprising an authoring tool for authoring the digital content distributed by the contend server in a form amenable to the structure/system/architecture.

8. Re. to claim 81: The rationale for rejection of claim 80 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture wherein the authoring tool encrypts the digital content according to a decryption key and stores information on the digital content and the encryption key in a content-key database.

09/290,530
Art Unit 2165

9. Re. to claim 82: The rationale for rejection of claim 81 are incorporated. The examiner submits that the content of this claims are notoriously well-known in computer-related art: a structure/system/architecture wherein the license server accesses the information on the digital content and the encryption key in the content-key database prior to issuance of a license corresponding to the digital content, and includes the decryption key with such license as issued.

The examiner also submits that all claimed's limitations are well-known in the art (see extra cited references, and submitted IDS); cited prior art's limitations are not necessary spelled-out exactly claimed languages, because these prior references are also directed to a similar system/method for digital rights management. Cited prior arts are not limited to the described embodiments in these disclosures. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these inventions have been described in connection with specific preferred embodiments, it should be understood that the invention as claimed should not be unduly limited to such specific embodiments.

09/290,530
Art Unit 2165

10. Re. to Claims 2, 3, 32, 33, 84, 85: These claims are obvious similarly to limitations of claim 57. Therefore, same rationale and references would be applied for under 35 U.S.C. § 103(a) rejections.

11. Re. to Claims 4, 5, 34, 33, 86, 87: These claims are obvious similarly to limitations of claim 58. Therefore, same rationale and references would be applied for under 35 U.S.C. § 103(a) rejections.

12. Re. to Claims 6, 35, 88: These claims are obvious similarly to limitations of claim 59. Therefore, same rationale and references would be applied for under 35 U.S.C. § 103(a) rejections.

13. Re. to Claims 30-55: These claims have product-by-process formats. Therefore, same rationale and references of claims 56-82 would be applied for under 35 U.S.C. § 103(a) rejections as reasons below:

In MPEP 2113, the use of 35 U.S.C. § 102/103 rejections for product-by-process claims has been approved by the courts. "The lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We

09/290,530
Art Unit 2165

are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the status is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparison therewith." In re **Brown**, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972)."

In other words: "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even thought the prior art product was made by a different process."

In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

The examiner submits that all claimed limitations are inherent/well-known in a computer system, because these claimed limitations are very broad that they are easily recognized to be components of a computer system and said components would perform claimed tasks/steps; cited prior art's limitations are not

09/290,530
Art Unit 2165

necessary spelled-out exactly claimed languages, because cited prior art is also directed to a similar process/system for transferring money from a safe. Stefik or IDS references are not limited to the described embodiments in their inventions. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although their invention has been described in connection with specific preferred embodiments, it should be understood that their invention as claimed should not be unduly limited to such specific embodiments.

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the system of Stefik with suggestions readily available in the art submitted in the IDS, because these information would improve communication and security for a digital right management system.

Conclusion

14. Claims **1-105** are rejected.
15. The attached references are considered pertinent to applicants' disclosure.
 - Stefik, (US Pat. 5,715,403), discloses about a system for controlling the distribution and use of digital works having

09/290,530
Art Unit 2165

attached usage rights where the usage rights are defined by a usage rights grammar.

- Stefik et al., (US Pat. 5,629,980), discloses about a system for controlling the distribution and use of digital works.
- Van Wie et al., (US Pat. 5,943,422), discloses about a steganographic techniques for securely delivering electronic digital rights management control information over insecure communication channels.
- Ginter et al., (US Pat. 5,982,891), discloses about a system and a method for secure transaction management and electronic rights protection.

16. Remarks: The following are US Patent case-law rulings applying in this examination.

A. Some claims in this application could be objected to under 37 CFR 1.75 as being a substantial duplicate of a claim. E.g. when two claims in an application are duplicates are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Applicants are advised that should a claim be found allowable, another claim would be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

09/290,530
Art Unit 2165

B. When a claim or part of a claim is defined in computer program code as in this application, whether in source or object code format, a person of ordinary skills in the art must be able to ascertain the metes and bounds of the claimed invention. In certain circumstances, as where self-limitations, not present in the claims, were improperly imported from the specification. See also *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

C. In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998), the court ruled: "The name of the game is the claim."

D. The examiner submits that the reasons for rejection are obvious (v.s. cited prior arts) with **claims' language**. In re **Mraz**, 59 CCPA, F.2d, 173 USPQ 25, 28 (1972), it says: "Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter".

E. Although operational characteristics of a system may be apparent from the specification, we will not read such characteristics into the claims when they cannot be clearly connected to the structure recited in the claims (e.g. in claim 1, a means-plus-function format is used for the functions of: for distributing the content, for issuing licenses, for receiving distributed contents, for receiving and storing licenses corresponding to digital content, for rendering content, for

09/290,530
Art Unit 2165

being invoked by ..., for determining whether ...). See **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. See also **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990); ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim").

F. In re Conrad, 169 USPO 170 (CCPA 1971), the court said:

The test for obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest.

G. In re Heck, 216 USPO 1038 (CA FC 1983)

Similarly relative terms in claims are given broadest reasonable interpretation during patent application's prosecution.

H. In re Keller, Terry, and Davies, 208 USPO 871 (CCPA 1981)

09/290,530
Art Unit 2165

"It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

I. Ex parte Rubin, 5 USPO2d 1461 (BdPatApp&Int 1987):

Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

J. In re Susi, 169 USPO 423 (CCPA 1971): Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments.

K. In re Heck, 216 USPO 1038 (Fed. Cir. 1983): "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain."

L. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if

09/290,530
Art Unit 2165

the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987); in this application, it is so obvious to one with skills in the art to apply these limitations in a condition of non-networked accessing).

M. About carrying forward another's invention--Design choice to make integral:

In re Larson, 144 USPQ 347 (CCPA 1965), the court said: "While the brake disc and clamp of Tuttle et al. comprise several parts, they are rigidly secured together as a single unit. The constituent parts are so combined as to constitute a unitary whole. Webster's New International Dictionary (2nd edition) defines "integral" as "(2) composed of constituent parts making a whole; composite; integrated." We are inclined to agree with the board's construction of the term "integral" as used in claim 12. Then, too, we are inclined to agree with the position of the solicitor that the use of a one piece construction instead of the structure disclosed in Tuttle et al. would be merely a matter of obvious engineering choice. In re *Fridolph*, 50 CCPA 745, 89 F.2d 509, 135 USPQ 319; and in re Lockhart, 90 USPQ 214 (CCPA 1951) the court said: After a careful examination of the record, we do not find ourselves in agreement with appellant's argument. Although it is true that invention may be present under some

09/290,530
Art Unit 2165

circumstances in making integral that which was separate before, we do not feel that such is the case here. Improved results only will not take the case out of the general rule. There is also a requirement that the unification or integration involve more than mere mechanical skill. In re **Murray**, 19 CCPA 739, 53 F.2d 541, 11 USPQ 155; In re **Zabel et al.**, 38 CCPA 832, 186 F.2d 735, 88 USPQ 367. In this case, all of the essential elements of the appealed claims except integration of parts, are found in the references. It appears to us that the unity or diversity of parts would depend more upon the choice of the manufacturer, and the convenience and availability of the machines and tools necessary to construct the syringe, than on any inventive concept.

N. and in **Howard v. Detroit Stove Works**, 150 US 164 (CCPA 1893), the court said: "As to the 3rd patent, it is void because the claims in it were clearly anticipated, and because it involves no invention to cast in one piece an article which has formerly been cast in two pieces and put together, nor to make the shape of the grate correspond with that of the firepot".

P. The functions perform on this apparatus/system needs internal dedicated software that allows it to store, organize, retrieve, and transfer electronic money .etc., as computers cannot perform storage and retrieval functions without software.

09/290,530
Art Unit 2165

Any retrieval and storage function by computers would necessitate dedicated software, which the application does not disclose.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703) 305-4553. The examiner can normally be reached on Mon.-Fri. from 7AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin, can be reached on (703) 308-1065.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to: (703) 308-9051, (for formal communications)

Or: (703) 305-0040 (for informal or draft communications)

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Cuonghnguyen

Cuong H. Nguyen
Patent Examiner
April 12, 2001